

REMARKS/ARGUMENT

Claims 1-28 are currently pending.

The Office Action maintained the rejection of claims 1-28 under 35 U.S.C. § 103 as obvious over CA 2255456 (“Siray”). In support of its maintaining this rejection, the Office Action asserted that (1) no evidence existed that Applicants attempted to correct the inaccurate range in any counterpart of Siray; and (2) Siray’s Rule 132 declaration in which he stated that the range in question is inaccurate was insufficient as a matter of law because Siray was only one of the inventors named on Siray. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

Initially, Applicants note that for Siray to constitute invalidating prior art to the claimed invention, it must enable the production of silica having a tamped density of less than 70 g/l. “Where a process for making the compound is not developed until after the date of invention, the mere naming of a compound in a reference, without more, cannot constitute a description of the compound.” MPEP 2121.02(I).

During prosecution thus far, Applicants have submitted the Schubert Rule 132 declaration (August 20, 2007) in which Schubert demonstrated that none of Siray’s examples disclose precipitated silica having a tamped density of 20 to less than 70 g/l or a DBP number of 350-400 g/100 g, let alone precipitated silica having both of these characteristics. Also in the Schubert declaration, it was demonstrated that following the preparation methods exemplified in Siray would lead to silica having tamped density of 72-85 g/l and a DBP number of 320-333 g/100g. Thus, Applicants have provided evidence demonstrating that Siray does not disclose a process for producing silica having a tamped density of less than 70 g/l. In other words, one skilled in

the art, following Siary, would not be able to produce silica having a tamped density of less than 70 g/l. Accordingly, Applicants have demonstrated that a process for producing such silica was not known prior to the present invention.

Under such circumstances, Siray is not enabling for the production of the claimed silica, meaning that it is not a reference properly-relied upon and that the § 103 rejection is improper. MPEP 2121.02(I). For at least this reason, the pending rejection should be reconsidered and withdrawn.

Moreover, the assertions upon which the Office Action based its maintaining the rejection are unfounded. First, Applicants have corrected the disputed range in the corresponding Chinese application, an application which was pending at the time Applicants became aware of the presence of the inaccurate range. (See, Tab A, in which the range is always 70-140). Contrary to the implication behind the Office Action's assertion, merely because Applicants have not corrected the range in applications for which prosecution closed prior to their becoming aware of the inaccurate range does not mean that the range is accurate.

Second, Siray's declaration, by itself, is sufficient to demonstrate that the disputed range in Siray is inaccurate. The Office Action cites no authority for the proposition that every inventor on Siray must submit a declaration to demonstrate the inaccuracy of the disputed range. Rather, according to MPEP 716.01 (c), Siray's declaration, by itself, must be considered and is sufficient to demonstrate this point.

The pending § 103 rejection relies upon the assumption that the disclosure at page 4, line 17 of Siray is accurate. However, as Applicants have demonstrated (by the Rule 132 declaration

by Mustafa Siray), this is not the case. Because the pending rejection is based upon an erroneous assumption, the rejection itself is erroneous and should be withdrawn.

More specifically, in his declaration, Siray states that:

- Siray discloses silica having a tamped density of at least 70 g/l. With particular reference to Siray's wax-coated silica, Siray's abstract, Siray's claim 3 and the entire remainder of Siray's disclosure require the compacted density of wax-coated silica to be at least 70 g/l (70-140 g/l). This is consistent with Siray's understanding that the silica disclosed in Siray, including wax-coated silica, has a tamped density of at least 70 g/l. (Paragraph 3).
- The disclosure at page 4, line 17 is a typographical error. This line should have stated that the tamped density was 70-140 g/l in accordance with the remainder of Siray's disclosure. Siray never considered silica having a tamped density of 7-140 g/l to be part of the invention in Siray. (Paragraph 4).
- Siray agrees with the analysis of Siray's exemplified compositions which is set forth in the Schubert declaration (submitted August 20, 2007). In his declaration, Schubert demonstrated that none of Siray's examples disclose precipitated silica having a tamped density of 20 to less than 70 g/l or a DBP number of 350-400 g/100 g, let alone precipitated silica having both of these characteristics. Also in the Schubert declaration, it was demonstrated that following the preparation methods exemplified in Siray would lead to silica having tamped density of 72-85 g/l. and a DBP number of 320-333 g/100g. Schubert's findings and analysis are

consistent with Siray's understanding of the inventive silica disclosed in Siray.
(Paragraph 5).

Thus, according to Siray himself, Siray discloses silica having a tamped density of at least 70 g/l --- it does not teach or suggest silica having a tamped density of less than 70 g/l. The disclosure in Siray upon which the Office Action has based the pending rejection (page 4, line 17) is nothing more than a typographical error. Nowhere does Siray teach or suggest silica having a tamped density of less than 70 g/l.

In contrast, the amended claims require the tamped density to be less than 70. In fact, claims 27 and 28 require the tamped density to be 60 or less. Accordingly, no overlap exists with respect to tamped density of the claimed silica and the compacted density of Siray's silica.

For at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Finally, even assuming that a *prima facie* case of obviousness exists (which, as explained above, is not the case), sufficient data demonstrating superior and beneficial results associated with the claimed silica are disclosed in the present application to rebut any such hypothetical case of obviousness. More specifically, as demonstrated on page 7 of the present application, the invention silicas possess improved matting efficiency over comparative silicas.

As explained in the Schubert declaration, examples 1, 3, 4 and 5 correspond to the invention silicas. (See, Schubert declaration, par. 5). These examples all have gloss 60° values which are surprisingly lower than the gloss value of Example 2 (DBP number of 333 g/100 g) and the comparative composition containing Acematt HK 450. (See, Schubert declaration, par. 5). This difference in matting efficiency between the invention silicas and the comparative

silicas was surprising and unexpected given the similarity of the silicas. (See, Schubert declaration, par. 6). The difference in matting efficiency between the invention silicas and the comparative silicas demonstrates the surprising and unexpected benefit derived from having properties associated with the invention silicas. (See, Schubert declaration, par. 8). What's more, the improved matting efficiency associated with the invention silicas are commercially significant -- clearly, silicas which possess more effective matting properties are more commercially viable than less effective silicas. (See, Schubert declaration, par. 9).

In view of the above, Applicants respectfully submit that sufficient data exists demonstrating the unexpected and surprising matting properties of the claimed silicas to rebut any hypothetical *prima facie* case of obviousness which might exist.

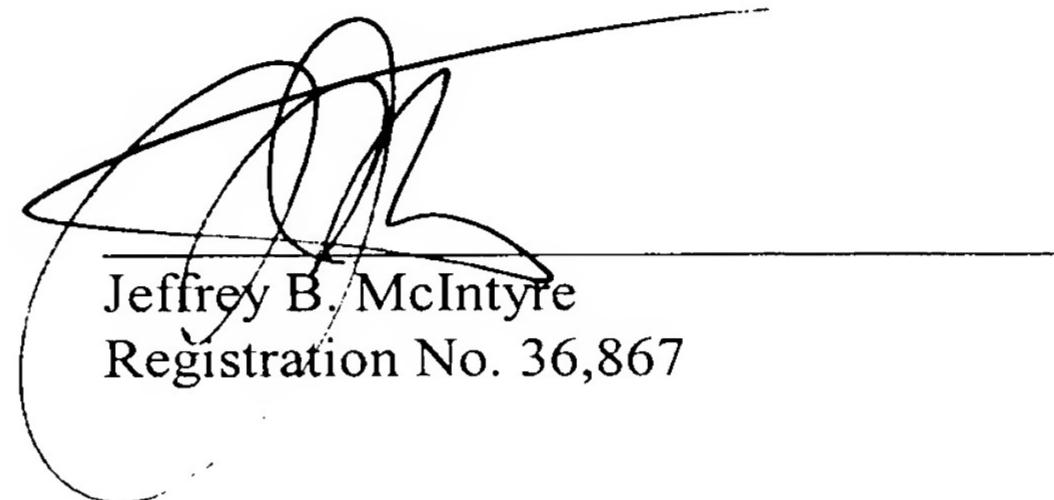
For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

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Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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